

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAKOTO TORIZUKA,
HIROHISA SUZUKI, KANA FUJIWARA,
TAKASHI ODA, NOBUSHIGE TANAKA and KATSUHIKO RINDO

Appeal No. 99-0389
Application 08/709,218¹

ORDER REMANDING TO EXAMINER

On October 27, 1998, a Reply Brief (Paper No. 13) was filed in response to the Examiner's Answer mailed August 27, 1998 (Paper No. 12). However, there is no indication in the record of whether or not the examiner has considered the Reply Brief. Section 1.193(b)(1) of the Code of Federal Regulations (1998) states:

¹ Application for patent filed September 6, 1996.

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(b)(1) Appellant may file a reply brief to
an examiner's answer within two months from

the date of such examiner's answer. . . .
The primary examiner must either
acknowledge receipt and entry of the reply
brief or withdraw the final rejection and
reopen prosecution to respond to the reply
brief.

In addition, an Information Disclosure Statement
(IDS) was filed June 11, 1999 (Paper No. 14) and has been
matched with this application at the Board of Patent Appeals
and Interferences. The IDS needs to be considered by the
Primary Examiner with respect to compliance with the criteria
set forth in 37 CFR §§ 1.97 and 1.98. A communication
notifying appellants of the Primary Examiner's decision is
required.

Finally, a further examination of the file reveals
that an amendment filed February 11, 1998 (Paper No. 8) was
not properly entered. Title 37 CFR § 1.122(a) (1997) states:

Amendments are "entered" by the
Office by making the proposed
deletions by drawing a line in red
ink through the word or words
cancelled, and by making the

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proposed substitutions or
insertions in red ink, small
insertions being written in at the
designated place and larger
insertions being indicated by
reference.

The current entry of the amendment does not comply with
37 CFR § 1.122(a).

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Accordingly, it is

ORDERED that the application is remanded to the
Examiner:

1. for proper response to the Reply Brief filed
October 27, 1998 (Paper No. 13);
2. for consideration of the IDS filed June 11, 1999
(Paper No. 14), including appropriate notification to
appellants;
3. for proper entry of the amendment filed
February 11, 1998 (Paper No. 8); and
4. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and
Interferences be informed promptly of any action affecting the
status of the appeal (i.e., abandonment, issue, reopening
prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: _____
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DS:psb

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